

DOCKET NUMBER: 95176562-0024001  
PATENT

## REMARKS

### Status of the claims

After amendment, claims 33-86 and 94-110 are pending. Claims 1-32 and 87-93 that were previously withdrawn have been cancelled. New claims 94-110 have been added. Claims 33, 44, 47, 64, 66 and 75 have been amended. Of the claims remaining after amendment, claims 33-49 and 64-77 currently stand rejected and claims 50-63 and 78-86 stand objected to.

### Amendment of the claims

Amendments to claims 33, 44, 47, 64, 66 and 75, and new claims 94-110 are, at least, supported by page 6, l. 13-page 8, l. 10; page 11, ll. 3-11; page 12, ll. 7-9; page 12, l. 21-page 13, l. 2; page 13, ll. 7-11; page 13, l. 19-page 14, l. 3; page 13, ll. 19-23; page 18, ll. 15-19; page 22, l. 21-page 30, l. 23; Example 1; Figures 5-18; and the original claims. New claims 94-97 are original claims 50, 51, 52 and 78 rewritten in independent form including limitations of original, independent claim 47 from which they all directly depended. Certain amendments were made to clarify the language of the claims.

### Claim objections to claims 47 and 64 due to informalities in claim language

Claims 47 and 64 were objected to. In the Office Action, claim 47 was said to be confusing, and Applicant has amended the claim to be more clear. Claim 64 has been amended, such that the term "a trailing" has been replaced by "a trailing edge," as suggested by the Examiner.

### Rejection of claims 33, 44, 47, 66 and 75 under 35 U.S.C. §112, second paragraph

Claims 33, 44, 47, 66 and 75 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention. Claims 33, 47 and 66 were rejected, because certain terms were found to lack proper antecedent bases. Claims 33, 47 and 66 have been amended to address this rejection. Claims 44 and 75 were rejected as being confusing, and have been amended to make the language more clear. In view of amendments, Applicant respectfully requests that the rejections of claims 33, 44, 47, 66 and 75 under 35 U.S.C. §112, second paragraph, be withdrawn.

DOCKET NUMBER: 95176562-0024001  
PATENT

Rejection of claims 33-37, 44-45, 47-49, 64-68 and 77 under 35 U.S.C. §102(b) as being anticipated by Zirkiev U.S. Patent Serial No. 5,745,999 ('999)

Independent claims 33 and 47 of the present application are directed to cutting devices configured in such a way that a substrate (*i.e.*, bone) remains fixed, while a cutter moves relative to said substrate during a cutting stroke by the device. Claims 34-37 and 44-45 depend from claim 33, and claims 48, 49, 64-68 and 77 depend from claim 47. Zirkiev '999 does not teach cutting devices that involve moving a cutter (*e.g.*, cutting blade) relative to a fixed substrate. Thus, Applicant respectfully requests that the rejection of claims 33-37, 44-45, 47-49, 64-68 and 77 as being anticipated by '999 be withdrawn.

Rejection of claims 38-43, 46 and 69-74 under 35 U.S.C. §103(a) as being unpatentable over Zirkiev '999

As explained above, independent claims 33 and 47 of the present application are directed to cutting devices configured in such a way that a substrate (*i.e.*, bone) remains fixed, while a cutter moves relative to the substrate during a cutting stroke by the device. Claims 38-43 and 46 depend from claim 33, and claims 69-74 depend from claim 47. Zirkiev '999 does not teach cutting devices that involve moving a cutter (*e.g.*, cutting blade) relative to a fixed substrate. Applicant respectfully requests that the rejection of claims 38-43, 46 and 69-74 as being unpatentable over '999 be withdrawn.

Objections to claims 50-63 and 78-86

Claims 50-63 and 78-86 were objected to as being dependent upon a rejected base claim, and the Office Action indicated that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. All of these claims depend from independent claim 47, which has been amended, and which should now be allowable. Thus, dependent claims 50-63 and 78-86 should now also be allowable.

As pointed out above, claims 50, 51, 52 and 78 were objected to as being dependent upon a rejected base claim. New claims 94-97 are original claims 50, 51, 52 and 78 rewritten in

DOCKET NUMBER: 95176562-0024001  
PATENT

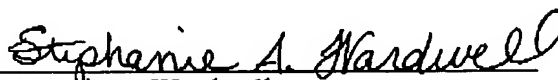
independent form including limitations of original, independent claim 47 from which they all directly depended. Therefore, new claims 94-97 should be allowable.

Conclusion

The application is respectfully submitted to be in condition for allowance, and prompt favorable action thereon is earnestly solicited. If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response; please charge any deficiency in fees or credit any overpayments to Deposit Account No. 50-1881 (95176562-0024001).

Respectfully submitted,  
Baker & McKenzie LLP

  
Stephanie A. Wardwell  
Reg. No. 48,025

W. Jackson Matney, Jr.  
Reg. No. 39,292

Date: September 22, 2006  
815 Connecticut Avenue, NW  
Washington, DC 20006  
Phone: 202-452-7000  
Facsimile: 202-452-7074